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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,062	07/30/2001	Donald J. Schremp	10004377-1	2666

7590

10/01/2002

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

PADMANABHAN, KARTIC

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,062

Applicant(s)

SCHREMP ET AL.

Examiner

Kartic Padmanabhan

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-70 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25, drawn to a device, classified in class 435, subclass 283.1.
 - II. Claims 26-35, drawn to a method for mixing materials, classified in class 435, subclass 4.
 - III. Claims 36-38, drawn to another method of mixing materials, classified in class 435, subclass 7.1.
 - IV. Claim 39, drawn to a method of carrying out a binding reaction, classified in class 436, subclass 518.
 - V. Claims 40-41, drawn to a method of detecting polynucleotides, classified in class 435, subclass 6.
 - VI. Claim 42, drawn to a method of detecting a polynucleotide, classified in class 436, subclass 815.
 - VII. Claims 43-52, drawn to a method of mixing materials, classified in class 422, subclass 68.1.
 - VIII. Claims 53-62, drawn to another method of mixing, classified in class 436, subclass 807.
 - IX. Claims 63-64, drawn to an apparatus, classified in class 436, subclass 155.
 - X. Claims 65-67, drawn to an apparatus, classified in class 436, subclass 524.
 - XI. Claims 68-70, drawn to a method, classified in class 435, subclass 969.

The inventions are distinct, each from the other because of the following reasons:

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2. Inventions I, IX, and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are devices with different functions and elements. The heating element that elevates temperature adjacent to the support of Invention IX is not required of the other groups. In addition, the O-ring of Invention X is not required of the other Inventions.

3. Inventions II-VIII, and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are methods with different functions and/or steps. The methods of Inventions II, III, VII, and VIII are all drawn to mixing, which is a different function than that of the other Inventions. In addition, the methods of mixing also differ from one another. The stream of gas of Inventions II, VII, and VIII is not required of Invention III. Also, the element of being free of an evaporation layer of Invention VII is not required of the other mixing Inventions. Invention VIII also differs from Invention II in that Invention II requires the support of Invention I. Inventions IV, V, VI, and XI (non-mixing methods) are also different from one another. Inventions V and VI differ from the other groups as being drawn to a method of detecting polynucleotides, a function that is unique to those groups. However, they also differ from one another in that only Invention V requires a residual amount of sample to remain. Inventions IV and XI differ from one another because they have different functions.

4. Inventions II-VIII and XI are related to Inventions I, IX, and X as processes and devices for their practice. The inventions are distinct if it can be shown that either: (1) the process as

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claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the methods of Inventions II-VIII and XI do not require the specifics of the devices of Inventions I, IX, and X. The methods, as claimed, could be practiced with the surface of another device, such as a microtiter plate. The specific methods steps of the method claims in no way appear to require the specific components of the apparatus Inventions, thereby rendering the inventions distinct.

5. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and the search required for one group is not required of the others, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan
Patent Examiner
Art Unit 1641

September 25, 2002


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

09/29/02